REMARKS

Claims 1-13, 15-22, 28-29, 31-42, 44-49, 55-64, 66-69, and 71-75 were pending in the application. By this paper, Applicant amended Claims 28 and 60, cancelled Claims 55-59, 68-69 and 71-75 without prejudice, and add new Claims 76-77. Accordingly, Claims 1-13, 15-22, 28-29, 31-42, 44-49, 60-64, 66-67, and 76-77 are presented for examination herein.

Request for Continued Examination (RCE)

Applicant files herewith an RCE for continued prosecution of the above-identified application.

§103 Rejections

1. Per page 2 of the Office Action, Claims 1, 3, 4, 6-10, 13, 15-22, 28, 29, 32-37, 40-42, 44-49, 55, 58-60, 63-64, 66-69, and 72-75 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks, et al. (U.S. Patent No. 6,463,585; hereinafter referred to as "Hendricks") in view of Kinder, et al. (WO Patent Publication No. 2001/91474; hereinafter referred to as "Kinder"). In response hereto, Applicant provides the following remarks.

Claim 1 – Applicant traverses the Office's §103 rejection of Claim 1 as being unpatentable over Hendricks in view of Kinder.

Applicant notes that *"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art."* In re Royka, 490 F.2d 981 (CCPA 1974). See MPEP 2143.03.

On page 3 of the Office Action, the Office states that Hendricks discloses *"a spot placement engine for determining which advertisements should occupy the pods during the broadcast programs based on the received information (col. 31, ll. 33-41) which meets 'in response to a detection of an indicator, generating at least one programming segment')"*. Applicant notes that even if one assumes *arguendo* that Hendricks discloses a feature which corresponds to in response to detection of an indicator generating a program segment, Claim 1 does not recite such a limitation. Claim 1 specifically recites *"in response to a detection of an indicator, generating a list of individual ones of the plurality of user terminals currently receiving the programming content"*. In other words, it is <u>the generation of a list of individual</u>

ones of the plurality of user terminals currently receiving the programming content which is performed in response to the detection of an indicator in Claim 1, and *not* the generation of at least one programming segment. Hendricks does on in any way teach or suggest generating a list of individual ones of the plurality of user terminals currently relieving the programming content in response to a detection of an indicator. Note also that at page 3 of the Office Action, the Office goes on to state that "*Hendricks is silent on in response to a detection of an indicator, generating a list of individual ones of the plurality of user terminals currently receiving the programming content*", thereby explicitly supporting Applicant's aforementioned contention.

Also at page 3 of the Office Action, the Office argues that Kinder discloses "*generating a list of individual ones of the plurality of user terminals currently receiving the programming content (page 5, ll. 1-3, 9-11, & figure 3, label 40 (the selector uses feedback tags to modify demographic mapping))*". Applicant notes that even if one assumes *arguendo* that the Office's argument is correct, nowhere does Kinder teach or suggest generating a list of individual ones of a plurality of user terminals currently receiving the programming content in response to a detection of an indicator.

Therefore, Applicant respectfully submits Hendricks and/or Kinder do not teach or suggest multiple ones of the limitations of Claim 1. Claim 1 distinguishes over the art of record, and thus is not rendered unpatentable thereby.

Claim 9 – Applicant respectfully traverses the Office's §103 rejection of Claim 9 as being unpatentable over Hendricks in view of Kinder.

At page 5 of the Office Action, the Office argues that Hendricks discloses "*a spot placement engine for determining which advertisements should occupy the pods during the broadcast programs based on the received information (col. 31, ll. 33-41) which meets 'in response to a detection of an indicator, generating at least one programming segment')*". Even if *arguendo* that Hendricks discloses a feature as asserted by the Office, such a feature does not meet the limitations of Claim 9. In particular, Claim 9 recites "*in response to a detection of an indicator, identifying a set of user terminals currently receiving the program stream*". Hence, it is the identification of a set of user terminals currently receiving the program stream which is performed in response to the detection of an indicator in Claim 9, and not the generation of at least one programming segment. Hendricks simply does not teach or suggest identifying a set of

user terminals currently receiving the program stream in response to a detection of an indicator (see e.g., the Office's statement at page 5 of the Office Action, "*Hendricks is silent on in response to a detection of the message, identifying a set of user terminals currently receiving the program stream.*")

Still further, at page 6 of the Office Action, the Office contends that Kinder discloses "*identifying a set of user terminals currently receiving the program stream; identifying one or more groups of user terminals within the set of user terminals currently receiving the program stream (page 5, ll. 1-3, 9-11, & figure 3, label 40 (the selector uses feedback tags to modify demographic mapping))*". Assuming *arguendo* that the Office's contention above is correct, nowhere does Kinder disclose the identification of a set of user terminals currently receiving the program stream in response to a detection of an indicator as recited in Claim 9.

At page 5 of the Office Action, the Office contends that Hendricks discloses generating at least one program segment. Even if one assumes *arguendo* that such a disclosure in Hendricks corresponds to the Claim 9 recitation of generating one or more data streams containing one or more alternate programming segments for substituting the scheduled programming segment (a point which Applicant does not necessarily concede), Hendricks simply does not teach or suggest generating these streams subsequent to, *and* based at least in part on, identifying one or more groups of user terminals within the set of user terminals currently receiving the program stream. See, for example, the Office's statement on pages 5-6 of the Office Action ("*Hendricks is silent on...generating, subsequent to and based at least in part on identifying one or more groups of user terminals within the set of user terminals currently receiving the program stream*").

At page 6 of the Office Action the Office contends that Kinder discloses "*generating, subsequent to and based at least in part on identifying one or more groups of user terminals within the set of user terminals currently receiving the program stream (page 5, ll. 12-14, page 5, ll. 7-9, page 5, ll. 6-23 & page 6, ll. 5-9, with emphasis on page 7, ll. 1-8).*" However, even if the Office's contention is correct, nowhere does Kinder teach or suggest the identification of one or more groups of user terminals within the set of user terminals currently receiving the program stream being the basis for generation of one or more data streams containing one or more alternative programming segments for substituting the scheduled programming segment, as is recited in Claim 9. In Kinder, alternative programming segments are neither generated nor substituted for the scheduled program segment.

Therefore, none of the references, including Hendricks and/or Kinder, teaches or suggests all of the limitations of Claim 9. Thus, Claim 9 is not rendered obvious thereby.

Claim 28 – Applicant respectfully traverses the Office's §103 rejection of Claim 28 as being unpatentable over Hendricks in view of Kinder.

At page 8 of the Office Action, the Office asserts that Hendricks discloses "*a processing unit (figure 4c, label 307) responsive to a detection of the indicator, generating at least one programming segment*". Even if one assumes *arguendo* that this assertion is correct, such a disclosure does not correspond to the limitations of Claim 28. In particular, Claim 28 recites "*a processing unit, responsive to a detection of the indicator, for generating a list of an audience currently receiving the programming content*". Hence, in Claim 28, it is the generation of a list of an audience currently viewing the programming content (and not the generation of at least one programming segment) which is performed in response to the detection of an indicator. Hendricks does not teach or suggest a processing unit responsive to a detection of the indicator for generating a list of an audience currently receiving the programming content (see e.g., page 8 of the Office Action, where the Office states "*Hendricks is silent on a processing unit, responsive to a detection of the indicator, for generating a list of an audience currently receiving the programming content*").

At page 9 of the Office Action, the Office asserts that Kinder discloses "*a processing unit, for generating a list of an audience currently receiving the programming content... (page 5, ll. 1-3, 9-11 & figure 3, label 40 (the selector sues the feedback tags to modify demographic mapping)*". Even if one assumes *arguendo* that the Office's assertion is correct, Kinder does not in any way teach or suggest generating the list of the audience currently receiving the programming content <u>in response to a detection of an indicator,</u> as is recited in the limitation of Claim 28.

However, in the interest of furthering prosecution of this application, Applicant has by this paper amended Claim 28 to recite limitations relating to (i) at least one of a plurality of transmission channels being utilized for the delivery of only the selected programming content, the plurality of transmission channels not being utilized for delivery of programming content which has not been selected by at least one user, and (ii) at least one of remaining ones of the plurality of transmission channels being utilized for the delivery of the at least one programming

segment. Support for these amendments may be found at, *inter alia*, page 10, lines 12-14 and page 14, lines 6-12 of Applicant's specification as filed.

Applicant respectfully submits that none of the art cited by the Office, including Hendricks and/or Kinder, teaches or suggest transmission channels not being utilized for delivery
5   of programming content which has not been selected by at least one user (so-called "switched broadcast" content delivery techniques).

Therefore, Claim 28 as amended herein distinguishes over the cited art, and is not rendered obvious thereby.

10   **Claim 36** – Applicant respectfully traverses the Office's §103 rejection of Claim 36 as being unpatentable over Hendricks in view of Kinder.

On page 10 of the Office action the Office states that Hendricks discloses "*a spot placement engine for determining which advertisements should occupy the pods during the broadcast programs based on the received information (col. 31, ll. 33-41) which meets "a*
15   *processing unit responsive to a detection of the message, responsive to a detection of the indicator, generating at least one programming segment")*".

Even if the Office's statement is correct, it is respectfully unfair to characterize the limitations of Claim 36 as above. Claim 36 does <u>not</u> recite the generation of one or more data streams (containing one or more alternate programming segments for substituting the scheduled
20   programming segment within the program stream) being in response to a detection of a message and/or a detection of the indicator. Rather, Claim 36 recites the <u>identification of a set of one or more user terminals</u> which is currently receiving the program stream, being responsive to the detection of the message. Note that per page 10 of the Office Action, "*Hendricks is silent on a processing unit responsive to a detection of the message, for identifying a set of one or more user*
25   *terminals which is currently receiving the program stream.*"

Furthermore, at page 11 of the Office Action, the Office asserts that Kinder discloses "*a processing unit, for identifying a set of one or more user terminals which is currently receiving the program stream generating a list of an audience currently receiving the programming content (page 5, ll. 1-3, 9-11 & figure 3, label 40 (the selector sues the feedback tags to modify*
30   *demographic mapping)).*" Applicant submits, however, that even if the Office's assertion is correct, nowhere does Kinder disclose the identification and/or generation being responsive to

the detection of the message. There is, respectfully, a difference between (i) merely identifying a set of user terminals (as is performed in Kinder), and (ii) identifying the terminals in response to the detection of a message (as recited in Claim 36).

Also per page 10 of the Office Action, the Office argues that Hendricks discloses 5 *"grouping said identified set of one or more terminals into one or more groups based on at least one characteristic... (figure 4c, label 309, col. 26, ll. 60-63 & col. 27, ll. 1-6)"*. Although Hendricks discloses grouping terminals in to one or more groups based on at least one characteristic (see e.g., col. 5, lines 1-13), Hendricks does not in any way teach or suggest grouping an identified set of terminals which are currently receiving the program stream as is 10 recited in Claim 36. Rather, in Hendricks the groups are identified from among <u>all of the user terminals</u> (not from an identified set thereof).

Furthermore, the groups are determined, in Hendricks, prior to any content delivery; thus, the groups are not of an identified set of terminals which are *currently receiving* the program stream.

15 Still further, Applicant notes that Claim 36 recites *"a processing unit responsive to a detection of the message for...grouping said identified set of one or more terminals into one or more groups based on at least one characteristic"*. Even if one assumes *arguendo* that Hendricks discloses grouping an identified set of one or more terminals into one or more groups based on at least one characteristic (a point which Applicant does not concede), nowhere does Hendricks 20 disclose this grouping being responsive to a detection of the message as recited in Claim 36. Rather, as noted above, Hendricks merely discloses grouping occurring prior to the delivery of content to the user terminals. The grouping is not responsive to a detected message.

At page 10 of the Office Action, the Office further asserts that Hendricks discloses *"grouping said identified set of one or more terminals into one or more groups based on at least 25 one characteristic, <u>the at least one characteristic comprising a function of at least the number of available transmission channels in the network</u> (figure 4c, label 309, col. 26, ll. 60-63 & col. 27, ll. 1-6)"*. {emphasis Examiner's} Applicant disagrees.

At e.g., col. 26, line 60 – col. 27, line 6, Hendricks merely discloses various criteria for segmenting the user terminals into groups. Hendricks discloses various examples of target 30 criteria including for example, *"demographic targeting (age/sex/income) and Area of Dominant*

Influence (ADI)." However, nowhere does Hendricks disclose grouping as a function of at least the number of available transmission channels, as is explicitly recited in Claim 36.

At page 10 of the Office Action, the Office also contends that Hendricks discloses "*...said alternate programming segment not being present in the programming schedule prior to said detecting (col. 31, ll. 28-30 & 33-36)*". Applicant disagrees.

Hendricks does not disclose the aforementioned limitation. Rather, at e.g., col. 31, lines 28-36, Hendricks merely indicates that "*the spot placement engine 307 then determines which of the available advertisements/promotions should air in each pod during the broadcast of a program.*" In other words, in Hendricks the advertisements/promotions are determined prior to the broadcast of the program; these are not created *a priori* or in real time as is recited in the invention of Claim 36 (the alternate programming segment not being in the programming schedule prior to said detecting).

Based on the foregoing, several of the limitations of Claim 36 are not taught or suggested by Hendricks and/or Kinder. Thus, Claim 36 is not rendered obvious thereby.

Claim 55 – Without remarking on the merit or propriety of the Office's rejection of this claim with respect to Hendricks and/or Kinder, Applicant has by this paper cancelled Claim 55 without prejudice, thereby rendering the rejection thereof moot.

Claim 60 – Applicant respectfully traverses the Office's §103 rejection of Claim 60 as being unpatentable over Hendricks in view of Kinder.

On page 8 of the Office action the Office states that Hendricks discloses "*a spot placement engine for determining which advertisements should occupy the pods during the broadcast programs based on the received information (col. 31, ll. 33-41) which meets "a processing unit (figure 4c, label 307), responsive to a detection of the indicator, generating at least one programming segment"*)". Even if the Office's statement is correct, the limitations of Claim 60 cannot reasonably interpreted as disclosing a processing unit responsive to a detection of the indicator, generating at least one programming segment. Rather, Claim 60 recites the generation of a list of an audience receiving the programming content during the scheduled presentation of the programming content as being responsive to the detection of the indicator Likewise, per page 8 of the Office Action, the Office goes on to state that "*Hendricks is silent on*

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a processing unit responsive to a detection of the indicator, for generating a list of an audience currently receiving the programming content".

With respect to the Office's assertion on page 9 of the Office Action, that Kinder discloses "generating a list of an audience receiving the programming content", Applicant notes
5   that the limitations of Claim 60 are properly interpreted as requiring the generation of the list as being responsive to the detection of the indicator. There is, respectfully, a salient difference between (i) merely generating a list of the audience receiving the programming content (as is arguably performed in Kinder), and (ii) generating a list of the audience receiving the programming content in response to the detection of the indicator (as recited in Claim 60).

10   Applicant further notes that the Office has failed to indicate in the portion of the Office Action directed to the rejection of Claim 60, where it is believed Hendricks and/or Kinder discloses the one or more advertisements not being present within the programming schedule prior to the detecting.

At page 10 of the Office Action, the Office contends that (with respect to the rejection of
15   Claim 36) Hendricks discloses "...*said alternate programming segment not being present in the programming schedule prior to said detecting (col. 31, ll. 28-30 & 33-36)".* Applicant disagrees.

Hendricks, at e.g., col. 31, lines 28-36, merely indicates that "*the spot placement engine 307 then determines which of the available advertisements/promotions should air in each pod during the broadcast of a program.*" Thus, in Hendricks the advertisements/promotions are
20   determined prior to the broadcast of the program.

However, in order to still further distinguish the invention of Claim 60 over the cited art, Applicant has by this paper amended Claim 60 to recite limitations relating to: (i) the available transmission channels comprising transmission channels which are allocated using switched broadcast techniques, and (ii) based at least in part on current requests for the content, a second
25   at least one advertisement data stream is provided in lieu of the advertising segment within the programming content, the second at least one advertisement data stream containing alternative advertisements targeted at a second selected group of the plurality of users. Support for this amendment may be found at, *inter alia*, page 10, lines 12-14 and page 14, lines 6-12 of Applicant's specification as filed.

30   Applicant submits that neither Hendricks nor Kinder teaches or suggests using switched broadcast techniques. Likewise, none of the references teaches or suggests based on current

requests for content providing a second advertisement data stream in lieu of the advertisement

segment within the programming content. Rather, the references discussed herein merely provide

targeted advertisements based on grouping established prior to the delivery of content thereto.

Neither reference in any way that Applicant can see discloses providing additional alternative

5   advertisement data streams based on the current requests for content, as recited in Claim 60.

Therefore, Applicant submits that Claim 60 distinguishes over the art on multiple distinct

bases, and is not rendered unpatentable thereby.

Claim 68 – Without remarking on the merit or propriety of the Office's rejection of this

10   claim with respect to Hendricks and/or Kinder, Applicant has by this paper cancelled Claim 68

without prejudice, thereby rendering the rejection thereof moot.

Claim 69 – Without remarking on the merit or propriety of the Office's rejection of this

claim with respect to Hendricks and/or Kinder, Applicant has by this paper cancelled Claim 69

15   without prejudice, thereby rendering the rejection thereof moot.

Claim 74 – Without remarking on the merit or propriety of the Office's rejection of this

claim with respect to Hendricks and/or Kinder, Applicant has by this paper cancelled Claim 74

without prejudice, thereby rendering the rejection thereof moot.

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Claim 75 – Without remarking on the merit or propriety of the Office's rejection of this

claim with respect to Hendricks and/or Kinder, Applicant has by this paper cancelled Claim 75

without prejudice, thereby rendering the rejection thereof moot.

25   *New Claims*

Applicant has thereby added a new independent Claim 76 and new dependent Claim 77.

These new claims correspond generally and without limitation to the subject matter of Claim 9 of

the present application. No new matter has been added.

New Claim 76 recites, *inter alia*: (i) based at least in part on the availability of a second

30   transmission channel, directing at least one user terminal within the first subset to tune from the

first transmission channel to the second transmission channel over which the first data stream

containing alternate programming segments is transmitted, and (ii) based at least in part on the availability of a third transmission channel, directing at least one user terminal within the second subset to tune from the first transmission channel to the third transmission channel over which the second data stream containing alternate programming segments is being transmitted.

5   Applicant respectfully submits that these limitations are not taught or suggested by Hendricks, Kinder, or the other art of record, in combination with the other limitations of Claim 76.

Other Remarks

10   Applicant hereby specifically reserves all rights of appeal (including those under the Pre-Appeal Brief Program), as well as the right to prosecute claims of different scope in another continuation or divisional application.
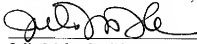
Applicant notes that any claim cancellations or additions made herein are made solely for the purposes of more clearly and particularly describing and claiming the invention, and not for

15   purposes of overcoming art or for patentability. The Office should infer no (i) adoption of a position with respect to patentability, (ii) change in the Applicant's position with respect to any claim or subject matter of the invention, or (iii) acquiescence in any way to any position taken by the Office, based on such cancellations or additions.

Furthermore, any remarks made with respect to a given claim or claims are limited solely

20   to such claim or claims.

If the Examiner has any questions or comments which may be resolved over the telephone, he is requested to call the undersigned at (858) 675-1670.

Respectfully submitted,

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GAZDZINSKI & ASSOCIATES, PC

Dated: September 9, 2010   By: _____

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